

REMARKS

Claims 1-4, 6-9 and 11-13 are pending in the above-identified application. This Supplemental Reply is being filed in response to the Interview discussed below.

Personal Interview Conducted with Examiner on April 29<sup>th</sup>

The Patent Examiner, together with his supervisor Mr. Greg Vidovich, conducted a personal Interview with applicant's representative on April 29, 2005. This Interview was very much appreciated.

The Interview Summary form generally describes the issues discussed at the Interview.

On page 3 of the Interview Summary form, the Patent Examiner describes regarding the substance of the Interview that applicant's representative had pointed out some distinctions between the claims of the present application and the reference primarily relied upon by the Patent Examiner, i.e. Wu '358 (USP 5,908,358). After the discussion regarding this issue, which has already been addressed during prosecution of this application, the Examiner and his supervisor pointed out that they believed that the comparative test results shown in the present application do not provide clear objective evidence supporting the advantages of the golf ball of the present invention. It is specifically stated in the comments of the

Interview Summary form that, "It was requested by the examiner and SPE if the hardness of the cover was critical for the performance of the invention and should be clarified if it is a functional objective or an aesthetic objective. Mr. Meikle agreed to look into the objective [evidence] and submit a declaration related to such." As a minor point of clarification, it is noted that applicant's representative stated that a "declaration" might be helpful, but did not commit to submitting a declaration (since this may not be necessary).

#### Support for Patentability Outside Comparative Tests

Before discussing the issues regarding the comparative tests which support the patentability of the present claims, it is noted that the previous Reply filed April 14, 2005, provided several other reasons in support of the patentability of the present claims based on the deficiencies of the cited references. Please note especially the discussion at pages 9-14 of the April 14<sup>th</sup> Reply which point out: [1] the failure of Wu '358 to disclose or suggest the specific diisocyanate compound employed to make the thermosetting urethane resin of the golf ball cover of the present invention; [2] the failure of Wu '358 to disclose or suggest the relationship ratio ranges between stiffness and hardness properties selected from the very large possible ranges (including large portions of the ranges

which exhibit poor properties); and [3] the inconsistencies between the golf ball cover composition of Wu '358 and the golf ball cover composition of Wu '294 (USP 6,210,294) which fails to employ any curing agent having an epoxy group as required for all the compositions described by Wu '358.

#### Objective Qualities of Test Results in Present Application

Focusing on the criticism of the comparative test results described in the present application, it is first noted that among the apparently "aesthetic" properties mentioned during the Interview were the "controllability" and "shot feeling" properties included in the comparative tests described at pages 15-27 of the present specification.

Regarding "controllability", it is submitted that the actual tests employed in connection with comparing this property corresponded to the following:

- "excellent": distance of "run" was less than 2 yards;
- "good": distance of "run" was 2-4 yards;
- "fair": distance of "run" was 4-6 yards; and
- "poor": distance of "run" was more than 6 yards.

The "run" was the distance that the golf ball traveled after initially striking the target surface. Thus, this property was measured in an objective manner, though all the specific details regarding the objectivity of this test were not detailed at page 17

of the present specification. Rather, the number of golfers applying this objective standard was reported.

Regarding "shot feeling", it is true that this property clearly includes a large subjective component, since this property is essentially a complete evaluation by the golfer of other properties including deformation amount, hardness distribution, etc. However, "shot feeling" has been employed in connection with other comparative tests and other U.S. patents. Note for example: [1] USP 6,241,625 (column 15); [2] USP 6,386,993 (column 7); and [3] USP 6,716,116 (column 5). Thus, testing for this property is accepted within the industry and the results of these tests should be given a reasonable amount of credibility by the Patent Examiner.

Another property reported in the present specification which includes an objective basis is "abrasion resistance". This property was evaluated based on the following:

"excellent": surface of golf ball had no flaws;

"good": surface of golf ball had 1 line (i.e. a linear shaped flaw made by a golf club head face groove) with a length of less than 3 mm;

"fair": surface of golf ball had 1 or 2 lines (defined above) with a length of more than 3 mm; and

"poor": surface of golf ball had more than 3 lines (defined above) with a length of more than 3 mm.

In view of the above, it is submitted that the comparative tests described in the present application have a reasonably

objective basis and should be given a reasonable amount of credibility by the Patent Examiner.

Conclusion

It is submitted that the claims of the present application are patentable over the cited references because of the deficiencies in the cited references noted in the Reply filed April 14<sup>th</sup> as indicated above. As a secondary position, it is submitted that the comparative tests results discussed in the present specification provide further evidence rebutting any asserted prima facie obviousness. It is additionally submitted that these comparative test results are based on reasonably objective observations and measurements such that these test results should be given reasonable credibility and fully considered by the Patent Examiner.

If any questions arise regarding the above matters, please contact Applicant's representative, Andrew D. Meikle (Reg. No. 32,868), in the Washington Metropolitan Area at the phone number listed below.

If necessary, the Commissioner is hereby authorized in this, concurrent, and future replies, to charge payment or credit any overpayment to Deposit Account No. 02-2448 for any additional fees


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required under 37 C.F.R. §§ 1.16 or 1.17; particularly, extension of time fees.

Respectfully submitted,

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By

  
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